REMARKS

I. General

Claims 1-25 are pending in the present application. The present Office Action (mailed September 21, 2006) rejects all of claims 1-25 and raises the following issues:

- A document cited in the IDS filed November 3, 2003 is not in the Examiner's possession;

- The title of the application is objected to;

- Claims 20-25 are rejected under 35 U.S.C. §101; and

- Claims 1-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,477,683 to Killian et al. (hereinafter "*Killian*") in view of Microsoft Visual Source Safe version 5.0 (hereinafter "*VSS*").

Applicant respectfully traverses the outstanding claim rejections raised in the current Office Action, and requests reconsideration and withdrawal thereof in light of the amendments and remarks presented herein.

II. Amendments

Claims 1, 10, 12, and 20 are amended herein, and claims 9, 19, and 21 are canceled without prejudice. No new matter is added by the amendments presented herein, *see* e.g., FIGURE 1 and discussion thereof in the present application.

More specifically, claim 1 is amended to include the element originally presented in dependent claim 9, *i.e.* "wherein said contextual information about said at least one component comprises genealogy information for said at least one component". Further, claim 1 is amended to clarify that the genealogy information "specifies a developmental relationship between said at least one component and at least one other component in said repository." This clarifies that the

genealogy information includes information regarding the developmental relationship of the recited component to another component, rather than merely the edit history of the recited component in isolation.

In view of the above amendment to claim 1, dependent claim 9 is canceled without prejudice. And, because claim 9 is canceled, claim 10 is amended to depend from claim 1, rather than from canceled claim 9.

Claim 12 is amended to include the element originally presented in dependent claim 19, *i.e.* "wherein said contextual information about said components comprises genealogy information for said components". Further, claim 12 is amended to clarify that the genealogy information "specifies a developmental relationship between said components in said repository." In view of the amendment to claim 12, dependent claim 19 is canceled without prejudice.

Claim 20 is amended to include the element originally presented in dependent claim 21, *i.e.* "wherein said contextual information for the firmware components comprises genealogy information for said firmware components". Further, claim 20 is amended to clarify that the genealogy information "specifies a developmental relationship between said firmware components in said repository." In view of the amendment to claim 20, dependent claim 21 is canceled without prejudice.

III. IDS

Applicant notes that the Examiner has not considered the document "Intel Itanium Architecture Software Developer's Manual", Vol. 2, cited in the IDS filed November 3, 2003 as the document is not in the Examiner's possession. However, the cited portions of the document "Intel Itanium Architecture Software Developer's Manual", Vol. 2, referenced in the IDS filed November 3, 2003 were submitted with such IDS. The full document "Intel Itanium Architecture Software Developer's Manual", Vol. 2, is quite lengthy (529 pages), and so for the Examiner's convenience, Applicant cited and supplied only those portions believed to be most

relevant to the present application. Applicant respectfully re-submits herewith those relevant portions of "Intel Itanium Architecture Software Developer's Manual", Vol. 2, that were cited in the IDS filed November 3, 2003, and requests that the Examiner consider the cited portion of the document. Further, should the Examiner desire to review the full document "Intel Itanium Architecture Software Developer's Manual", Vol. 2, Applicant will provide the full document to the Examiner upon request.

IV. Objection to the Title of the Application

The present Office Action objects to the title of the application asserting that it should not have legal words like "method" and "system", *see* page 2 of the Office Action. The Examiner cites no authority for this objection, and offers no explanation as to why words like "method" and "system" are considered "legal words" that are not permitted in a patent application's title. Applicant finds no authority in 37 C.F.R. §1.72 or M.P.E.P. §606 for objecting to an application's title for containing the words "method" and "system". Further, a review of the USPTO's online database of issued patents reveals that since 1976 the USPTO has issued 329,586 patents that have a title containing the word "system" and 641,637 patents that have a title containing the word "method". Thus, this further evidences that no authority exists for objecting to the use of such words which are so widely used in patent titles issued by the USPTO. Accordingly, Applicant respectfully requests that the objection to the title of the application be withdrawn.

V. Rejections Under 35 U.S.C. §101

Claims 20-25 are rejected under 35 U.S.C. §101. Applicant respectfully traverses this rejection for the reasons discussed below.

35 U.S.C. §101 provides:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Thus, 35 U.S.C. §101 defines four categories of inventions that Congress deemed to be appropriate subject matter of a patent: processes, machines, manufactures, and compositions of matter. The latter three categories define "things" or "products" while the first category defines "actions". *See* 35 U.S.C. §100(b) ("The term 'process' means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.").

As the Supreme Court held, Congress chose the expansive language of 35 U.S.C. §101 so as to include "anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980). The Federal Circuit has embraced this perspective:

> The plain and unambiguous meaning of section 101 is that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set for in Title 35, such as those found in sections 102, 103, and 112. The use of the expansive term "any" in section 101 represents Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101 and the other parts of Title 35 ... Thus, it is improper to read into section 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations. *In re Alappat*, 33 F.3d 1526, 1542, 31 USPQ2d 1545, 1556 (Fed. Cir. 1994).

Accordingly, a complete definition of the scope of 35 U.S.C. §101, reflecting Congressional intent, is that any new and useful process, machine, manufacture, or composition of matter (or any new and useful improvement thereof) under the sun that is made by man is the proper subject matter of a patent.

The subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature, and natural phenomena. These three judicial exclusions recognize that subject matter that is not a practical application or use of an idea, a law of nature, or a natural phenomena is not patentable. *See, e.g., Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939) ("While a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be."). The courts have

held that a claim may not preempt ideas, laws of nature, or natural phenomena. Accordingly, one may not patent every "substantial practical application" of an idea, law of nature, or natural phenomena because such a patent "in practical effect be a patent on the [idea, law of nature or natural phenomena] itself." *Gottschalk v. Benson*, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972).

Claim 20 recites:

> A system comprising:
> a plurality of different design centers communicatively coupled by a communication network to a repository, said repository accessible by firmware developers of the design centers; and
> wherein said repository stores firmware components and contextual information for the firmware components and wherein said contextual information for the firmware components comprises genealogy information for said firmware components that specifies a developmental relationship between said firmware components in said repository.

Claims 21-25 depend from claim 20, and are likewise directed to a system. Accordingly, claims 20-25 are directed to a "system", and thus fall within one of the four statutory categories of section 101 (e.g., machine, manufacture, or composition of matter). The Office Action fails to establish that the claims are directed to a section 101 judicial exception (i.e., an abstract idea, law of nature, or natural phenomena). The USPTO guidelines explain that if an Examiner determines that the claimed invention preempts a section 101 judicial exception, "the Examiner must identify the abstraction, law of nature, or natural phenomenon and explain why the claim covers every substantial practical application thereof." The Office Action fails to offer any such explanation.

The Office Action appears to erroneously contend that claims 20-25 are directed to either a method or to computer software, *see* pages 2-3 of the Office Action. However, as provided above, claims 20-25 are clearly directed to a "system" that comprises "a plurality of different design centers communicatively coupled by a communication network to a repository". Thus, Applicant contends that claims 20-25 are directed to proper statutory subject matter under 35 U.S.C. §101, and therefore requests that this rejection be withdrawn.

VI. Rejections Under 35 U.S.C. §103(a) over *Killian* in view of *VSS*

Claims 1-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Killian* in view of *VSS*. Applicant respectfully traverses these rejections as discussed below.

To establish a prima facie case of obviousness, three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. Without conceding any other criteria, Applicant respectfully asserts that the applied combination of *Killian* and *VSS* fails to teach or suggest all claim elements.

<u>Independent Claim 1</u>

Independent claim 1, as amended herein, recites:

> A method for developing firmware, the method comprising:
> defining a framework for firmware to be developed by firmware developers at different design centers;
> at least one of said firmware developers developing firmware as at least one component within said framework; and
> depositing said at least one component within a repository that is accessible from all of said design centers, wherein said repository includes contextual information about said at least one component deposited therein and <u>wherein said contextual information about said at least one component comprises genealogy information for said at least one component that specifies a developmental relationship between said at least one component and at least one other component in said repository</u>. (Emphasis added).

The combination of *Killian* and *VSS* fails to teach or suggest at least the above-emphasized element of claim 1. That is, neither *Killian* nor *VSS* teaches or suggests contextual information about a component that specifies a developmental relationship between the component and another component.

Killian does not teach or suggest any such contextual information. To the extent that *Killian* teaches or suggests a developmental relationship between different firmware components, *Killian* provides no teaching or suggestion of storing contextual information that specifies such developmental relationship.

Further, *VSS* does not teach or suggest such contextual information. *VSS* appears to provide a file management tool that provides an environment that developers can use for managing their software code files. The *VSS* management tool allows for the files to be checked-out and checked-in to allow developers to coordinate their editing of the files. The *VSS* tool appears to allow developers to define a "project" in which all files for a given project can be stored under the defined project/directory, which aids the developers to better organize and find files related to a given project. The *VSS* tool also provides a history service for each file. For instance, page 15 of *VSS* explains:

> Visual SourceSafe tracks files on a change-by-change basis; the program has several different versions of any one file in its database. This is known as its *history*. In the example crisis just narrated, you could easily call up the file's history, choose the version of the file you know is correct, then roll back to an earlier version. This makes history a valuable tool for correcting errors; its applications, however, can be much larger.

> History allows you to track usage and changes within the file. From a managerial point of view, this is invaluable. You can determine who has accessed the file how many times, and more importantly, how many changes they made. In the case of an ever-evolving project, you can track down what changes occurred when, in order to determine what changes were the beginning of a new paradigm, and which were creeping featuritis.

VSS does not teach or suggest storing contextual information about a component that specifies a developmental relationship between the component and another component. As provided in the above-quoted portion of *VSS*, the history service of *VSS* does not specify a developmental relationship between different components. Rather, the history service of *VSS* tracks the edit history of a given file (or component), and stores earlier versions of the given file. Thus, changes within the given file can be tracked. This feature of *VSS* aids developers in editing and tracking changes to a given file. However, the *VSS* history service does not specify a

developmental relationship between different components. For instance, while the *VSS* history

service may be useful in tracking the edit history of a given component, it does not specify the

developmental relationship of the given component to any other components (e.g., whether the

given component is an extension of or developed from another component, etc.). Accordingly,

the *VSS* history service is useful in tracking edits to a given component, but fails to provide

developers any insight as to the developmental relationship of the given component to other

components in a repository. As the present application explains, enabling developers to

understand how different firmware components have evolved through development from other

firmware components is often helpful, particularly across different design centers.

Because the combination of *Killian* and *VSS* fails to teach or suggest storing contextual

information about a component that specifies a developmental relationship between the

component and another component, Applicant respectfully requests that the rejection of claim 1

be withdrawn.

Independent Claim 12

Independent claim 12, as amended herein, recites:

> A business method for development of firmware across a plurality of
> design centers, said business method comprising:
> defining a framework for firmware to be developed at different design
> centers;
> developing firmware as components within said framework at at least
> some of the design centers;
> depositing said components within a repository that is accessible by all of
> said design centers, wherein said repository includes contextual information about
> said components deposited therein and <u>wherein said contextual information about
> said components comprises genealogy information for said components that
> specifies a developmental relationship between said components in said
> repository</u>. (Emphasis added).

The combination of *Killian* and *VSS* fails to teach or suggest at least the above-

emphasized element of claim 12. That is, as discussed above with claim 1, neither *Killian* nor

VSS teaches or suggests contextual information about components that specifies a developmental

relationship between the components. Therefore, Applicant respectfully requests that the

rejection of claim 12 be withdrawn.

Independent Claim 20

Independent claim 20, as amended herein, recites:

> A system comprising:
> a plurality of different design centers communicatively coupled by a
> communication network to a repository, said repository accessible by firmware
> developers of the design centers; and
> wherein said repository stores firmware components and contextual
> information for the firmware components and wherein said contextual
> information for the firmware components comprises genealogy information for
> said firmware components that specifies a developmental relationship between
> said firmware components in said repository. (Emphasis added).

The combination of *Killian* and *VSS* fails to teach or suggest at least the above-

emphasized element of claim 20. That is, as discussed above with claim 1, neither *Killian* nor

VSS teaches or suggests contextual information about firmware components that specifies a

developmental relationship between the firmware components. Therefore, Applicant

respectfully requests that the rejection of claim 20 be withdrawn.

Dependent Claims

Dependent claims 2-8, 10-11, 13-18, and 22-25 each depend either directly or indirectly

from respective independent claims 1, 12, and 20 and, thus, inherit all of the limitations of their

respective independent claims. It is respectfully submitted that dependent claims 2-8, 10-11, 13-

18, and 22-25 are allowable at least because of their dependence from their respective base

claims for the reasons discussed above. Accordingly, Applicant respectfully requests the

withdrawal of the rejection of claims 2-8, 10-11, 13-18, and 22-25.
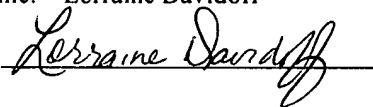
VII. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 100200410-2 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 629201481 US, in an envelope addressed to: MS Amendment, Commissioner for Patents, Alexandria, VA 22313.

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